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10/758,154	01/14/2004	Saul Le-Garcia Rodolfo	D0932-00416	5769

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT PAPER NUMBER

3636

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,154

Applicant(s)

RODOLOFO ET AL.

Examiner

Tamara L. Graysay

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133): Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 15 and 17-26 is/are rejected.
- 7) ☒ Claim(s) 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because of the following:
 - FIGS. 1-8: the view numbers must be larger than the numbers used for reference characters, as required by 37 CFR 1.84(u).
 - They fail to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 180 (FIG. 3).
 - They fail to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: "37" at [0038].

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:
 - [0032] at line 3: [[14]] should be 114
 - [0038] at line 9: [[10 110]] should be 10, 110

Appropriate correction is required.

Claim Objections

3. Claims 1 and 28 are objected to because of the following informalities:
- Claim 1, line 10: [[a soffit and siding accessory]] should be a soffit accessory and a siding accessory because there are two accessories that “are received” and not one accessory.
 - Claim 28, line 6: [[a soffit and siding panel]] should be a soffit panel and a siding panel because there are two panels that “are received” and not one panel.

Appropriate correction is required.

4. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

- Claim 29: the claim does not further limit claim 13 because the specification defines integral as being one-piece (at [0024]) and claim 13, line 5, recites a siding accessory receiver component “integral with” said soffit receiver component and the aesthetic component is intermediate thereof and thus must be integral or one-piece with the siding accessory receiver component integral and soffit receiver component.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 4, 5, 8, 10-12, 15 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 4: line 2 recites “an attachment edge portion;” however, claim 1 at line 5 recites “an attachment portion.” The claim is unclear as to whether the two recited elements are the same or different from each other. Clarification is required. The claim has been treated as though the elements are the same.
- Claim 8: as written lines 8-11 recite a broad range followed by a narrow range. Specifically, at lines 8-10 the broad range is recited wherein the vent apertures are included on one of four elements (1- bottom portion of the soffit receiver component, 2- connecting portion of the soffit receiver component, 3- front portion of the siding accessory receiver component, or 4- connecting portion of the siding accessory receiver component); and at lines 10-11 the narrow range is recited wherein the vent apertures are included on two elements (1- connecting portion of the siding accessory receiver component, and 2- front portion of the siding accessory receiver component). Therefore, the claim as rewritten is unclear as to whether the claim is limited to the broad range or the further limiting narrow range. The claim has been treated as being limited to the narrower range.
- Claim 22: lines 6-7 attempt to further limit the installing step by excluding an installing step. This is indefinite insofar as the installing step is confusing because the installing step is limited by excluding an installing step. If applicant desires to claim a method or process that is limited by the number or performance of the steps or activities, then the process would be properly claimed as “consisting of” rather than reciting steps that are not performed. A hypothetical potential infringer may perform the claimed providing step and the claimed installing step, and then perform a step of installing a separate piece to cover the vent apertures. Whether the claim is infringed or not by the hypothetical potential infringer is not clear when the “without installing” step that is sought to be excluded from the “installing” step is later performed in a step alone or in combination with other activities, i.e., installing a separate piece to cover the vent apertures to form a

weatherproof building. Thus, the metes and bounds of patent protection desired is not clearly set forth in the claim as written.

- Claim 26: see the rejection applied to claim 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-7, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiedegger (US-6421964).

Claim 1: Schiedegger discloses a trim accessory (18; FIG. 3) comprising a soffit receiver component (34, 28); a siding accessory receiver component (25, 26, 30) integral with the soffit receiver component (via 22, 24); the soffit receiver component having an attachment portion (the horizontally extending portion of 28) shaped and positioned to be attached to a building (FIGS. 1, 2); and an additional portion (vertically extending portion 24) of the trim accessory, separate and distinct from the attachment portion (the horizontally extending portion of 28), the additional portion (vertically extending portion 24) having a plurality of vent apertures (48, 49) disposed therethrough and located so that they are hidden from view when the trim accessory is installed on the building (along with the aesthetic component (20; FIG. 6)). The limitation “at least *when* the trim accessory is installed and a soffit accessory and a siding accessory are received” is a conditional statement that does not structurally define over the trim accessory of Schiedegger that includes the element 20, for example, which obstructs the view of the vent apertures on the additional portion 24.

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Claim 3: The aesthetic component (22, 24) is located intermediate the soffit receiver component and siding accessory receiver component and formed from the same piece of material as the soffit receiver component (28, 34) and siding accessory receiver component (25, 26, 30) (FIG. 3). The intended use of the component to be “aesthetic” does not structurally define over the element 22, 24 of Schiedegger.

Claim 4: Schiedegger further discloses the soffit receiver component comprising an attachment edge portion (the horizontal portion of element 28), a bottom portion (horizontal portion of element 34), and a connecting portion (the vertical portion of element 28), and wherein the siding accessory receiver component comprising a back edge portion (the horizontal portion between 25 and 30), a front portion (the vertical/horizontal portion of element 30) and a connecting portion (the vertical portion 25, 26).

Claim 5: Schiedegger connecting portion (the vertical portion 25) includes vent apertures (50).

Claim 6: Schiedegger further discloses a vent component (22, 24) connected to the soffit receiver component (34, 28) and located intermediate the soffit receiver component (34, 28) and the siding accessory receiver component (25, 26, 30). The vent component (22, 24) includes vent apertures (48, 49).

Claim 7: Schiedegger further discloses (FIG. 3) a first end of element 22, 24 directly connected to the soffit receiver component (at the top end) and a second end of element 22, 24 directly connected to the siding accessory receiver component.

Claim 17: Schiedegger discloses a trim system (FIG. 2) comprising a trim accessory (18; FIG. 3) having a soffit receiver component (34, 28) defining a soffit receiving channel (31); a siding accessory receiver component (25, 26, 30) defining a siding accessory receiving channel (29) and the siding accessory receiver component (25, 26, 30) integral

with the soffit receiver component (via 22, 24); the soffit receiver component having an attachment portion (the horizontally extending portion of 28) shaped and positioned to be attached to a building (FIGS. 1, 2); and an additional portion (vertically extending portion 24) of the trim accessory, separate and distinct from the attachment portion (the horizontally extending portion of 28), the additional portion (vertically extending portion 24) having a plurality of vent apertures (48, 49) disposed therethrough and located so that they are hidden from view when the trim accessory is installed on the building (along with the aesthetic component (20; FIG. 6)). The limitation “at least *when* the trim accessory is installed and a soffit accessory and a siding accessory are received” is a conditional statement that does not structurally define over the trim accessory of Schiedegger that includes the element 20, for example, which obstructs the view of the vent apertures on the additional portion 24. Schiedegger further discloses a soffit panel (116) and a siding accessory (in the form of panel 13).

Claim 18: Schiedegger further discloses a vent component (22, 24) connected to the soffit receiver component (34, 28) and located intermediate the soffit receiver component (34, 28) and the siding accessory receiver component (25, 26, 30). The vent component (22, 24) includes vent apertures (48, 49).

Claim 19: The aesthetic component (22, 24) is located intermediate the soffit receiver component and siding accessory receiver component and formed from the same piece of material as the soffit receiver component (28, 34) and siding accessory receiver component (25, 26, 30) (FIG. 3). The intended use of the component to be “aesthetic” does not structurally define over the element 22, 24 of Schiedegger.

Claim 20: The aesthetic component (22, 24) is a crown molding, as broadly recited, insofar as the component runs between the top of a wall and a ceiling.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiedegger (US-6421964) as applied to claim 1 above, and further in view of Bachman (US-5836113).

Claim 2: Schiedegger discloses the trim assembly extruded from plastic (3:39-42).

Schiedegger does not explicitly mention that the extruded thermoplastic is polyvinylchloride.

Bachman teaches a bracket system for securing soffit and siding panels comprised of polyvinylchloride (4:60-63). Bachman mentions that the material is used in the siding, i.e., building trim, art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the plastic of Shiedegger to be polyvinylchloride, such as taught by Bachman, in order to provide an inexpensive, easy to assemble, and durable plastic.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiedegger (US-6421964) as applied to claim 17 above, and further in view of Olson (US-2809728).

Claim 21: Schiedegger, as interpreted for this claim, discloses a siding accessory receiving channel having a siding panel in the siding accessory receiving channel.

Schiedegger lacks a siding accessory between the siding panel and the siding accessory receiving channel.

Olson teaches a siding accessory (16) between a panel (13) and a receiving channel (18). The siding accessory (16) is used to “protectively enclose edge margins of sheet elements” (for example, 1:34-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the trim assembly of Schiedegger to include a siding accessory between the siding panel and the siding accessory receiving channel, such as suggested by Olson, in order to protectively enclose edge margins of the siding panel.

9. Claim 22-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiedegger (US-6421964).

Claim 22: Schiedegger depicts a trim system installed on the exterior of a building (FIGS. 1, 2) and mentions “securing a hanger member to an exterior wall” (2:45-48). In order to perform the securing step, one of ordinary skill in the art at the time the invention was made would have found obvious, in order to perform the securing step, to perform the steps of providing and installing in the method comprising: providing a trim accessory (18) having a soffit receiver component (34, 28); a siding accessory receiver component (25, 26, 30) integral with the soffit receiver component (via 22, 24), and vent apertures (48, 49); and installing the trim accessory on the exterior surface of the building such that the vent apertures are hidden from view, without installing a separate piece to cover the vent apertures. The apertures 48, 49 are hidden from view from below because the horizontally extending portion that forms the channel 29 inherently obstructs the view of the apertures 48, 49 from below.

Further, as noted in the rejection under 35 U.S.C. 112, second paragraph, the claimed installing step is indefinite and does not preclude later performing steps (mentioned at 2:48-63), for example, “positioning” “exerting force” and releasing

pressure” thereby securing element 20 between the soffit receiver component and siding accessory receiver component.

Claims 23 and 24: Though not explicitly mentioned, FIGS. 1, 2 of Shiedegger depicts the result of a step of installing a soffit panel (16) into the soffit receiving channel of the soffit receiver component and the result of a step of installing a siding accessory (13) into a siding accessory receiving channel of the siding accessory receiver component.

Claim 26: Schiedegger depicts a trim system installed on the exterior of a building (FIGS. 1, 2) and mentions “securing a hanger member to an exterior wall” (2:45-48). In order to perform the securing step, one of ordinary skill in the art at the time the invention was made would have found obvious, in order to perform the securing step, to perform the steps of providing and installing in the method comprising: providing a trim accessory (18) having a soffit receiver component (34, 28); a siding accessory receiver component (25, 26, 30) integral with the soffit receiver component (via 22, 24), and a vent component (22, 24) wherein the vent component includes vent apertures (48, 49); and installing the trim accessory on the exterior surface of the building such that the vent apertures are hidden from view, without installing a separate piece to cover the vent apertures. The apertures 48, 49 are hidden from view from below because the horizontally extending portion that forms the channel 29 inherently obstructs the view of the apertures 48, 49 from below.

Further, as noted in the rejection under 35 U.S.C. 112, second paragraph, the claimed installing step is indefinite and does not preclude later performing steps (mentioned at 2:48-63), for example, “positioning” “exerting force” and releasing pressure” thereby securing element 20 between the soffit receiver component and siding accessory receiver component.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiedegger (US-6421964) as applied to claim 24 above, and further in view of Olson (US-2809728).

Claim 25: Schiedegger, as interpreted for this claim, discloses a siding accessory receiving channel having a siding panel in the siding accessory receiving channel.

Schiedegger lacks a siding accessory between the siding panel and the siding accessory receiving channel.

Olson teaches a siding accessory (16) between a panel (13) and a receiving channel (18). The siding accessory (16) is used to “protectively enclose edge margins of sheet elements” (for example, 1:34-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Schiedegger method to include installing a siding accessory into a siding accessory receiving channel of the siding accessory receiver component and installing a siding panel into the siding accessory, such as suggested by Olson which depicts the panel 13 installed in the siding accessory 16 which is installed in the channel 18, in order to protectively enclose edge margins of the siding panel.

Allowable Subject Matter

11. Claims 13, 14, 16, 28 and 29 allowed. However, the objections made above with regard to claims 28 and 29 must be obviated.

12. Claim 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

13. Claims 10-12 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tamara L. Graysay
Examiner
Art Unit 3636

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